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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,593	06/07/2001	Benoit Van Den Eynde	L0461/7099	9143

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EXAMINER

YU, MISOOK

ART UNIT PAPER NUMBER

1642

DATE MAILED: 10/14/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/674,593

Applicant(s)

EYNDE ET AL.

Examiner

MISOOK YU, Ph.D.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,8,9,12,13,25,66,67,71-76,80 and 81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25,74-76,80 and 81 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 8, 9, 12, 13, 66, 67, 71-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1, 2, 8, 9, 12, 13, 25, 66, 67, and 71-76, 80, and 81 are pending and examined on merits.

#### ***Claim Objections***

The objection of the Claims is withdrawn in view of the amendment.

#### ***Claim Rejections - 35 USC § 112***

Claim 1 2, 12, 13, 66, 67, and 73 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The newly amended base claim 1 recites "a RUR-1 encoded polypeptide". The specification at page 11 under the heading Brief Description of the Sequences say that SEQ ID NO:5 is the amino acid of the polypeptide encoded by the RUR-1 cDNA and SEQ ID NO:2 is the amino acid of the polypeptide encoded by the RUR-1 antisense cDNA. The specification at page 28 lines 14 and 15 says "RUR-1 sense-encoded or RUR-1 antisense-encoded polypeptides". It is not clear which polypeptide is "RUR-1 encoded polypeptide" based on the disclosure of the originally filed specification. Reciting a SEQ ID NO corresponding to "RUR-1 encoded polypeptide" would obviate this rejection.

Any other rejection not repeated here is withdrawn in view of the amendment.

Claims 1 2, 12, 13, 66, 67, and 73 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

Art Unit: 1642

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is new matter rejection. The newly amended claim 1 recites "a RUR-1 encoded polypeptide". The specification at page 11 under the heading Brief Description of the Sequences say that SEQ ID NO:5 is the amino acid of the polypeptide encoded by the RUR-1 cDNA. SEQ ID NO:2 is the amino acid of the polypeptide encoded by the RUR-1 antisense cDNA. The specification at page 28 lines 14 and 15 says "RUR-1 sense-encoded or RUR-1 antisense-encoded polypeptides". However, the specification as originally filed does not describe "a RUR-1 encoded polypeptide". Applicant is requested to point out the support for the limitation in the originally filed specification. This rejection affects all dependent claims.

***Claim Rejections - 35 USC § 102***

Claims 8, 9, 71, and 72 remain rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. 5,582,979 (Dec. 10, 1996) and also remain rejected under 35 U.S.C. 102(e) as being anticipated by US Pat. 6,087,485 (filing date: Jan. 21, 1998).

Applicant argue that the art of record does not anticipate the invention because only a portion, of SEQ ID NO:32 of US Pat. 5,582,979 or SEQ ID NO:1 of US Pat. 6,087,485 and the instantly claimed fragment, matches. This argument is not commensurate in scope of the claims because the instantly claims are not limited to nucleic acid molecule consisting of 12-1381 contiguous nucleotides of the instant SEQ ID NO:1 but also includes any nucleic acid molecule comprising 12-1381 contiguous

Art Unit: 1642

nucleotides of SEQ ID NO:1. Note the claim construction of the dependent claim 9, for example. The limitation "consisting of" in line 2 of the base claim is part of Markush language. The art, for example US Pat. 5,582,979, teaches a nucleic acid molecule comprising 23 contiguous nucleotides of instant SEQ ID NO:1.

***Allowable Subject Matter***

Claims 25, 74-76, 80, and 81 are allowed.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU, Ph.D. whose telephone number is 703-

Art Unit: 1642

308-2454. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Misook Yu  
October 6, 2003

*Mary E. Mosher*  
MARY E. MOSHER  
PRIMARY EXAMINER  
GROUP 1800 7600